



14 DEC 2006

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In re Application of
YI et al.

Application No.: 10/525,241

PCT No.: PCT/US03/26356

Int. Filing Date: 22 August 2003

Priority Date: 23 August 2002

Attorney Docket No.: 7512.145

For: ASSEMBLY OF CHITOSAN ONTO AN
ELECTRODE SURFACE

DECISION ON

DECLARATION

This is a decision on applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally" "Request for Correction of Inventive Entity" and "Submission of Declaration under 37 CFR 1.497(d)", filed on 20 September 2006 in the United States Patent and Trademark Office (USPTO), requesting acceptance of the declaration in the above reference application.

BACKGROUND

On 17 March 2006, applicant filed a declaration in response to the 19 August 2005 Notification of Missing Requirements, identifying the international application and listed Li-Qun Wu and Mark J. Kastantin, among those listed in the published international application, as inventors. Applicant did not provide Form PCT/IB/306 adding Li-Qun Wu and Mark J. Kastantin as co-inventors.

On 19 April 2006, a Notification of Defective Response was mailed to applicant indicating that the declaration was unacceptable because (1) it was not executed in accord with 37 CFR 1.66 or 1.68 and (2) inventors Li-Qun Wu and Mark J. Kastantin were not listed on the published application.

On 16 May 2006, applicant filed a response along with a copy of the Request for Recording of A Change to add Li-Qun Wu and Mark J. Kastantin as a co-inventors under PCT Rule 92bis.

On 31 August 2006, a decision was mailed on the submission indicating that the declaration as submitted was not in compliance with 37 CFR 1.497(a) and (b) and that the application was abandoned. A Notification of Abandonment was mailed to applicant on 8 September 2006

On 20 September 2006, applicant filed a petition to revive along with "Request for Correction of Inventive Entity" and "Submission of Declaration under 37 CFR 1.497(d)".

DISCUSSION

As previously indicated, Li-Qun Wu and Mark J. Kastantin were not named as inventors in the published international application PCT/US03/26356. The declaration submitted on 16 May 2006 identifies Li-Qun Wu and Mark J. Kastantin as co-inventors and thus is not in compliance with 37 CFR 1.497(a) and (b). Since Li-Qun Wu and Mark J. Kastantin were not accepted under PCT Rule 92*bis* as co-inventors, it is improper to accept the declaration identifying them as co-inventors. Applicant now files a petition under 37 CFR 1.497(d) to add Li-Qun Wu and Mark J. Kastantin as inventors.

Petition under 37 CFR 1.497(d)

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(I); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

Applicants satisfied Items (1) and (2) above.

With regard to Item (3), applicant provided a Written Consent of The University of Maryland Biotechnology Institute, The University of Maryland, College Park and The University of Maryland, Baltimore County (assignees) to correct the inventorship under 37 CFR 1.497(d)(3) consenting to the addition of Li-Qun Wu and Mark J. Kastantin as inventors in this application. However, this statement was signed by: Claude Nash, identified as VP-ORD for The University of Maryland Biotechnology Institute; James A. Poulos, III, Executive Director, The University of Maryland Office of Technology Commercialization; and Stephen Anvil, Director, Technology Development The University of Maryland, Baltimore County.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. The submission is not in compliance with 37 CFR 3.73(b)(2)(I) as it is not clear from the written consent that Mr. Poulos or Mr. Anvil has such authority.

The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. In foreign countries, a person who holds the title "Manager" or "Director" is normally an officer and is presumed to have the authority to sign on behalf of the organization. A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee. The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(I). The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the

submission on behalf of the assignee, if a copy of the resolution is submitted in the record. A statement that the person having apparent authority to sign on behalf of the assignee is required. Item (3) above has not yet been satisfied.

Accordingly, applicant has not met all of the requirements to add Li-Qun Wu and Mark J. Kastantin as co-inventor in the above-identified international application.

Furthermore, even if Li-Qun Wu and Mark J. Kastantin were properly added as inventors, the declaration as submitted is not in compliance with 37 CFR 1.497(a) and (b). The declaration is comprised of three pages, containing one page 1 and three duplicate page 2 signature pages and four duplicate page 3 signature pages. Each page 2 and page 3 is executed by a different inventor. It appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

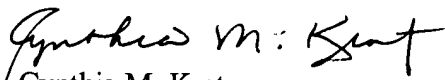
CONCLUSION

The declaration executed by Li-Qun Wu and Mark J. Kastantin as a joint inventors in the above referenced application is unacceptable and not in compliance with 37 CFR 1.497(a) and (b). A new declaration, in compliance with 37 CFR 1.497(a) and (b), and executed by the inventors as listed in the published international application, is required.

The petition to revive under 37 CFR 1.137(b) and Request for Correction of Inventive Entity in the above-captioned application are hereby **DISMISSED**. The proper reply, a declaration in compliance with 37 CFR 1.497(a) and (b), has not yet been submitted.

The application remains **ABANDONED** for failure to provide the proper reply.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Enclosure: FORM PCT/RO/132

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

PCT

To:

THOMAS P. LINIAK
LINIAK BERENATO & WHITE LLC
6550 ROCK SPRING DRIVE
SUITE 240
BETHESDA, MARYLAND 20817

COMMUNICATION IN CASES FOR WHICH
NO OTHER FORM IS APPLICABLE

Date of mailing
(day/month/year)

02 Jun 2006

Applicant's or agent's file reference

7512.145

REPLY DUE

See paragraph 1 below

International application No.

PCT/US03/26356

International filing date
(day/month/year)

22 Aug 2003

Applicant

UNIVERSITY OF MARYLAND BIOTECHNOLOGY INSTITUTE

1. ☐ REPLY DUE within _____ months/ days from the above date of mailing
☐ NO REPLY DUE, however, see below _____
☒ IMPORTANT COMMUNICATION
☐ INFORMATION ONLY

2. COMMUNICATION:

This is in response to applicants' "REQUEST TO CORRECT INVENTORSHIP UNDER RULE 92bis" filed 22 February 2005 and 16 May 2006 to add two more inventors, Le-Qun Wu and Mark J. Kastantin, to the present application. Applicants' request is REFUSED because under PCT Rule 92bis.1(b) "The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date." In the present case, the request was made to the RO/US one day prior to the expiration of the 30 months mentioned above, and therefore, this Office was unable to transmit such request to the International Bureau in due time for recording under PCT Rule 92bis.

Name and mailing address of the receiving Office

Mail Stop PCT, Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Facsimile No. 703-305-3230

Authorized officer

Ngoc-Ho Nguyen

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